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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/027,199	12/20/2001	Byoung S. Kwon	740.013US3	2369
759	90 06/28/2004		EXAM	INER
Jane Massey Licata, Esq.			LANDSMAN, ROBERT S	
Licata & Tyrrell	P.C.			
66 E. Main Stree	et		ART UNIT	PAPER NUMBER
Marlton, NJ 08053			1647	
		DATE MAILED: 06/28/2004		

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)			
Office Action Commons	10/027,199	KWON, BYOUNG S.			
Office Action Summary	Examiner	Art Unit			
	Robert Landsman	1647			
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply					
A SHORTENED STATUTORY PERIOD FOR REPLY THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply If NO period for reply is specified above, the maximum statutory period w  - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	86(a). In no event, however, may a reply be time within the statutory minimum of thirty (30) days rill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONEI	nely filed s will be considered timely. the mailing date of this communication. D (35 U.S.C. § 133).			
Status					
1) Responsive to communication(s) filed on	· .				
2a) ☐ This action is <b>FINAL</b> . 2b) ☐ This	action is non-final.				
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.					
Disposition of Claims					
4)⊠ Claim(s) <u>1-18</u> is/are pending in the application.					
4a) Of the above claim(s) is/are withdrawn from consideration.					
5) Claim(s) is/are allowed.					
6) Claim(s) is/are rejected.		•			
7) Claim(s) is/are objected to.					
8) Claim(s) <u>1-18</u> are subject to restriction and/or election requirement.					
Application Papers					
9)☐ The specification is objected to by the Examiner					
10)☐ The drawing(s) filed on is/are: a)☐ accepted or b)☐ objected to by the Examiner.					
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).					
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).					
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.					
Priority under 35 U.S.C. § 119					
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:					
1. Certified copies of the priority documents have been received.					
2. Certified copies of the priority documents have been received in Application No					
3. Copies of the certified copies of the priority documents have been received in this National Stage					
application from the International Bureau (PCT Rule 17.2(a)).					
* See the attached detailed Office action for a list of the certified copies not received.					
Attachment(s)	🗖 :				
Notice of References Cited (PTO-892)   Notice of Draftsperson's Patent Drawing Review (PTO-948)	4) ∐ Interview Summary (I Paper No(s)/Mail Date				
B) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) 🔲 Notice of Informal Pa	tent Application (PTO-152)			
Paper No(s)/Mail Date	6)				

## DETAILED ACTION

## 1. Election/Restriction

- A. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, drawn to a cDNA encoding H4-1BB, classified in class 536, subclass 23.5.
  - II. Claim 5-7, drawn to a H4-1BB protein, classified in class 530, subclass 350.
  - III. Claims 8-9, drawn to a monoclonal antibody, classified in class 530, subclass 387.1.
  - IV. Claims 10-13, drawn to a method of using the antibody, classified in class 435, subclass 7.2.
  - V. Claims 14-15, drawn to a fusion protein, classified in class 530, subclass 402.
  - VI. Claims 16-17, drawn to a method of detecting cell membrane ligands, classified in class 435, subclass 7.1.
  - VII. Claim 18, drawn to a method of inducing B-cell proliferation, classified in class 435, subclass 7.2.
- B. The inventions are distinct, each from each other because of the following reasons:

Inventions I, II, III, V are independent and distinct, each from each other, because they are products which possess characteristic differences in structure and function and each has an independent utility that is distinct for each invention which cannot be exchanged. The nucleic acid of Invention I can be used to make a hybridization probe, or can be used in gene therapy as well as to produce the peptide of Invention II. The peptide of invention II can be used for purposes other than to make an antibody of Invention III, such as a fusion protein, or used therapeutically or diagnostically (e.g. in screening). The antibody of Invention III can be used for reasons other than to obtain the peptide of Invention II. For example, the antibody may be used in diagnostics (e.g. as a probe in immunoassays, or in immunochromatography), or therapeutically.

Inventions I, II, V are unrelated to Invention IV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Inventions I, III are unrelated to Invention VI, VII. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different

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functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Invention II is unrelated to Invention IV, VII. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Inventions II and VI are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process of using that product MPEP § 806.05(h). In the instant case the protein can be used to make antibody.

Inventions III and IV are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process of using that product MPEP § 806.05(h). In the instant case the antibody can be used to purify protein.

Invention V is unrelated to Invention IV, VI, VII. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Inventions IV, VI, VII are independent and distinct, each from the other, because the methods are practiced with materially different process steps for materially different purposes and each method requires a non-coextensive search because of different starting materials, process steps and goals.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter as defined by MPEP § 808.02, the Examiner has *prima facie* shown a serious burden of search (see MPEP § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

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C. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17 (h).

## Advisory information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (703) 306-3407. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Fax draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Robert Landsman, Ph.D. Patent Examiner Group 1600 June 24, 2004

PATENT EXAMINER